

Remarks

Claims 1-8 are pending in the subject application. By this Amendment, Applicant has amended the abstract and claim 7 to correct a typographical error. Claim 1 has been amended to incorporate subject matter not previously rejected in this matter under 35 U.S.C. § 103(a) and claim 8 has been amended to recite one of the elements incorporated into claim 1. Claims 9-10 have been added to recite other elements from previously presented claim 8, said elements now having been incorporated into claim 1. Finally, claims 11-12 have been added to this application, support for which can be found, for example, at page 21, lines 10-17, page 28, line 10 through page 30, line 5 and page 32, lines 10-20. Applicant respectfully submits that this amendments will require no further search or examination on the part of the Examiner and does not constitute new matter. Entry and consideration of the amendment presented herein is respectfully requested. Accordingly, claims 1-12 are currently before the Examiner. Favorable consideration of the pending claims is respectfully requested.

As an initial matter, Applicant gratefully acknowledges the Examiner's withdrawal of the objections to the claim, as well as the rejections under 35 U.S.C. §112, first and second paragraphs, and the rejections of obviousness-type double patenting.

After consideration of this response, and prior to the issuance of another Office Action in this matter, Applicants' representative requests that the Examiner contact the undersigned in order to discuss any remaining issues in this application, as it is believed that any remaining issues will be of a relatively minor nature that can easily be attended to via a supplemental amendment or Examiner's amendment to the claims.

Claims 1-4 and 6 have been rejected under 35 U.S.C. § 103(a) as obvious over Kose (U.S. Published Application No. 2004/0156886). Applicant respectfully traverses this rejection. It is well established that to assert *prima facie* obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art (*In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974)). It has also been well established that the fact that a claimed species or subgenus is encompassed by a prior art genus is not sufficient by itself to establish a *prima facie* case of obviousness (see *In re Baird*, 29 USPQ2d 1550, 1552 (Fed. Cir. 1994)). With regard to the Office Action, there has been no effort made to explain why one of ordinary skill in the art would have been

motivated to make the compositions of the claimed invention. (*See, e.g., In re Ochiai*, 71 F.3d 1565, 1569-70, 37 USPQ2d 1127, 1131 (Fed. Cir. 1995); *In re Deuel*, 51 F.3d 1552, 1557, 34 USPQ2d 1210, 1214 (Fed. Cir. 1995)) While Kose recites a vast array of possible ingredient choices, there is provided no guidance in the reference directing one of ordinary skill in the art to specifically select the claimed compounds and compositions thereof. Kose simply recites different ingredients that could possibly be mixed, in any combination or quantities, with the materials comprising the patch agent. There is also no mention in the reference of the specific advantage of utilizing particular ingredients or combinations thereof, as disclosed and claimed in the subject application. Applicant urges that only with the benefit of the instant application does the advantage of utilizing the claimed combination of ingredients become apparent after reading the Kose reference. In view of the above comments, it is respectfully submitted that a *prima facie* case of obviousness has not been established for the claimed invention. However, in an effort to advance prosecution in this matter, Applicant has amended the independent claim to include the limitations of previously pending claim 8, a claim not rejected in this matter. Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a) is respectfully requested.

Claims 1-8 are rejected under the judicially created doctrine of “obviousness-type” double patenting over claims 1-6 and 11-27 of co-pending application U.S. Serial No. 10/868,697. Applicant respectfully submits that the claims of the subject application are not obvious over those in the cited application. However, in an effort to expedite prosecution, the Applicant submits herewith a Terminal Disclaimer to obviate this rejection. Accordingly, it is respectfully requested that this rejection be withdrawn.

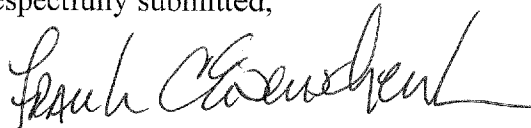
It should be understood that the amendments presented herein have been made solely to expedite prosecution of the subject application to completion and should not be construed as an indication of Applicants’ agreement with or acquiescence in the Examiner’s position. Applicants expressly reserve the right to pursue the invention(s) disclosed in the subject application, including any subject matter canceled or not pursued during prosecution of the subject application, in a related application.

In view of the foregoing remarks and amendments to the claims, Applicant believes that the currently pending claims are in condition for allowance, and such action is respectfully requested.

The Commissioner is hereby authorized to charge any fees under 37 CFR §§1.16 or 1.17 as required by this paper to Deposit Account No. 19-0065.

Applicant invites the Examiner to call the undersigned if clarification is needed on any of this response, or if the Examiner believes a telephonic interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,



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Attachment: Terminal Disclaimer